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U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143  
Response to First Office Action

### **PROPOSED REMARKS**

In response to the Office Action dated March 3, 2004, Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the claims as presented are in condition for allowance.

The United States Patent and Trademark Office (the "Office") rejected claims 1-36 under 35 U.S.C. § 102 (e) as being anticipated by U. S. Patent 6,564,261 to Gudjonsson *et al.* The Office also rejected claims 21, 35, and 36 under 35 U.S.C. § 103 (a) as being unpatentable over Gudjonsson. The Assignee shows, however, that the amended claims are patentably distinguishable, and the Assignee thus respectfully submits that the pending claims are ready for allowance.

#### **Rejection of Claims 1-36 under 35 U.S.C. § 102 (e)**

The Office rejected claims 1-36 under 35 U.S.C. § 102 (e) as being anticipated by U. S. Patent 6,564,261 to Gudjonsson *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, amended, independent claims 1, 12, and 24, and thus the dependent claims thereunder, are patentably distinguishable over Gudjonsson. The reference to Gudjonsson does not anticipate this invention, so the Assignee respectfully requests that Examiner Lezak remove the 35 U.S.C. § 102 (e) rejection of claims 1-36.

Independent claims 1, 12, and 24 have been amended to clarify that this invention allows the user to select the communications path. That is, when the user wishes to initiate communication with a member of a communications circle, this invention allows that user to select which contact device is desired. As the application states, the user "can choose the best

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method of communication to initiate communication with" the member. U.S. Application 09/709,038 at page 3, lines 13-14; page 4, lines 1-2; and page 13, lines 13-16. As this application also states, the user can click various tab indicators to select a member's wireless phone, voice mail, computer, email, wireline telephone, pager, electronic messaging, and/or interactive television. See U.S. Application 09/709,038 at page 3, line 15 through page 4, line 4; page 10, lines 4-16; page 13, lines 14-16; page 15, line 16 through page 17, line 4; page 17, lines 3-12; page 21, lines 9-12; and FIG. 3.

*Gudjonsson* does not anticipate independent claims 1, 12, and 24. *Gudjonsson* does not permit the user to select which contact device is desired. *Gudjonsson*, in contradistinction, utilizes a "routing service" that automatically establishes a "rendezvous" between users. This routing service uses software logic to determine where a communication is delivered — the users need not have any knowledge of another's client device. As *Gudjonsson* explains, the "routing service for the receiving user determines, according to a logic specified by the same receiving user, how the request is handled and what services are available to handle the request." See U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 3, lines 19-22. "[A] user may establish a communication session with another user *without knowledge of the client device ... being used by the other user; as the network arranges for communication ... between users regardless of the client device being used by the called user.*" See *id.* at column 3, lines 51-58 (emphasis added). "Thus, the network enables any of the above communication services between users, and the initiating user need not know whether the other user is currently online via his/her PC or may instead be reached via pager or mobile phone." See *id.* at column 3, lines 58-63 (emphasis added).

*Gudjonsson* continues explaining this "routing service." "In basic terms, aspects of the system/network act as broker(s), and can broker communication services between two or more people." See *Gudjonsson* at column 7, lines 52-54 (emphasis added). "When a user wishes to establish a communication with another user, he/she will invoke some function within his/her client, requesting the client to send an invitation of a given type to some selected user." See *id.* at column 9, lines 14-16. "The user's client will then form the correct SIP message and send it to a

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special service ... called the Routing Service (RS)." *See id.* at column 9, lines 17-20. *The "Routing Service (RS) of the called user (i.e. the callee) will decide how this invitation should be handled, without the calling user (i.e. caller) having to know how the communications channel between the users was set-up or on what network."* *See id.* at column 10, lines 33-37 (emphasis added). "The receiving RS decides what to do with the invitation according to user specified logic and available back-end services." *See id.* at column 13, lines 28-30.

*Gudjonsson* also provides an example. "[W]hen user A sends user B a message, as in FIG. 3, the following happens: 1) User A's client sends user A's routing service the message; 2) *User A's routing service ... runs it's "outgoing routing logic" ...*; 3) *User B's routing service receives the message ... and runs its "incoming routing logic."* *See Gudjonsson* at column 22, lines 29-39 (emphasis added). "[B]oth the outgoing routing logic and the incoming routing logic can decide to forward the message ... , store the message ... , or deliver the message down to the user's client." *See id.* at column 22, lines 45-51. The routing logic can be based on "a number of parameters" and "profiles" defined by the client." *See id.* at column 23, lines 13-32.

*Gudjonsson* also discusses the advantages of this "routing service." "[R]outing services offer benefits both for the caller (invitor) and the callee (invitee)." *See Gudjonsson* at column 13, lines 46-48. "For the caller it hides the messy details on how to locate and reach a given person/user at any given time." *See Gudjonsson* at column 13, lines 49-50 (emphasis added).

*Gudjonsson*, then, does not anticipate independent claims 1, 12, and 24. *Gudjonsson*, as shown above, does not permit the user to select which contact device is desired. *Gudjonsson*, in contradistinction, utilizes a "routing service" that uses software logic to determine where a communication is delivered — the users need not have any knowledge of another's client device. Because *Gudjonsson* "hides the messy details" by not allowing the user to select which contact device is desired, *Gudjonsson* cannot anticipate independent claims 1, 12, and 24 of this invention. The Assignee, then, respectfully asks the Office to remove the § 102 rejection and to allow claims 1, 12, and 24.

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The dependent claims are also not anticipated. Because *Gudjonsson* does not anticipate independent claims 1, 12, and 24, the dependent claims are likewise unanticipated. The Assignee, then, respectfully asks Examiner Lezak to remove the § 102 rejection of the dependent claims.

**Rejection of Claims 21, 35, and 36 under 35 U.S.C. § 103 (a)**

The Office also rejected claims 21, 35, and 36 under 35 U.S.C. § 103 (a) as being obvious over *Gudjonsson*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As this response explains above, *Gudjonsson* does not teach or suggest all the limitations of claims 21, 35, and 36.

Claims 21, 35, and 36 are not obvious in view of *Gudjonsson*. Claims 21, 35, and 36 are dependent claims and, thus, incorporate all the limitations of the respective independent claim. Independent claims 1, 12, and 24, as explained above, have been amended to clarify that the user selects the desired communications path. That is, when the user wishes to initiate communication with a member of a communications circle, this invention allows that user to select which contact device is desired. *Gudjonsson*, in contradistinction, utilizes a "routing service" that automatically establishes a "rendezvous" between users. This routing service uses software logic to determine where a communication is delivered — the users need not have any knowledge of another's client device. Thus, *Gudjonsson* in no way teaches or suggests user selection of the contact device. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Gudjonsson* to provide user selection of the contact device. Because *Gudjonsson* does not teach or suggest all the claim limitations, the Assignee respectfully requests removal of the § 103 (a) rejection.

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